STATUS OF CLAIMS

Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 are pending.

Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 stand finally rejected.

No claims have been amended.

TELEPHONE INTERVIEW REQUESTED.

The undersigned left a voice mail message with Examiner O'Connor requesting a telephone interview with both Examiners Koppikar and O'Connor. No return call has been received. Examiner Koppikar's voice mail indicates that the Examiner is out of the office until February 13, 2009. Scheduling of a telephone interview is requested.

REMARKS

Reconsideration of the subject application is requested.

Rejection of Claims 3, 5-10 and 14-15 Pursuant to 35 U.S.C. 103(a)

Claims 3, 5-10 and 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi (U.S. Patent 5,950,169), in view of (2) Cutting Out the Middlemen (May 31, 1999), non-patent literature (hereinafter "Middlemen"), further in view of (3) "Customers of Foremost Insurance Group Companies Can Now File Claims on the Company's Web Site" (hereinafter "Foremost").

The Examiner Has Failed to Identify the Teachings of Middlemen on Which the Examiner Relies.

Applicant notes that the Office Action does not identify any teachings of Middlemen relied on in support of the rejection. As the rejection fails to indicate the basis for the rejection based on Middlemen, the Office has failed to present a proper prima facie case of obviousness as to any claim, and withdrawal of the rejections is respectfully requested.

In order to move forward with prosecution, Applicant responds to the Section 103 rejection of claims 3, 5-10 and 14-15 as if the rejection relied only on Borghesi and Foremost, and not Middlemen.

The Rejection of Claim 3 Relies on Clear Error in Interpretation of At Least the Foremost and Borghesi References

The rejection of claim 3 is respectfully traversed for at least the following reasons.

In order to render a claim unpatentable, all of the recited limitations thereof must be taught or suggested in the prior art. *See*, MPEP 2143.03; *see also, In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant submits the cited prior art fails to teach or suggest each of the limitations of any of the pending claims.

The Foremost Reference Clearly Fails to Teach At Least Two of the Limitations of Claim 3 for Which the Examiner Cites Foremost

Contrary to the Examiner's statement, Foremost fails to teach at least the limitations:

> a claim rehabilitation component aggregating services related to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing;
>
> wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services.

The Response to Arguments section of the Office Action alleges in Paragraph (1) that these limitations are taught in Foremost, Full Text Sections: Paragraphs 2-4. Those paragraphs of Foremost read as follows:

> "Filing claims online is an added convenience for our customers" says Edward L. Troutman, Foremost Senior Vice President of Claims. "It's one more way people can get information to us when they need to. Since we want to offer as many methods as possible for people to reach us, and with more and more people going online, this is a proactive way we can use technology to benefit the customer."
>
> From Foremost's home page, visitors reach the screen to begin filing a claim with just one click. "It's prominent on our home page, because it's important for people to get to this critical part of our site without a lot of maneuvering," explains Troutman. From there, visitors select the Foremost insurance product that applies (auto, home, mobile home, motor home or travel trailer) and begin filling in information about the loss. If the customer has all the information handy, it could take as little as five minutes to fill out the online form. "It's about as much time as it would take to fill up your car with a tank of gas and pay for it," Troutman says.
>
> After submitting the loss information, the customer receives a confirmation and instructions on what will happen next. "Filing a claim online is no substitute for

> the person-to-person services we offer," says Troutman. "When a loss is filed online, we then follow our standard procedure of contacting the customer the next business day and working one-on-one to settle the loss."

The above quoted excerpt describes filing a claim online, receiving a confirmation and instructions about what will happen next, followed by a call from a representative. There is nothing in these three paragraphs that remotely resembles the claimed "claim rehabilitation component aggregating services relating to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses." Indeed, there is no mention of aggregating services, automatically providing aggregated services to claimants, or rehabilitating sustained losses in Foremost.

The Office Action of 12/3/2008, in Paragraph (3) of the Response to Arguments Section, states:

> Applicants argue that Foremost cannot teach these features because in Foremost an individual contacts the customer. However, the Office would like to point out that even though an individual calls the insured (customer) this does not mean that Foremost does not teach the above mentioned features. In fact, as stated above, Foremost does in fact teach the above mentioned features and moreover there is nothing in the claims that state that an individual cannot contact or does not contact a customer or an insured.

The Applicants point out that not only does Foremost fail to teach the claimed limitations, but Foremost teaches an alternative way of processing claims. In Foremost, an individual contacts the claimant. In Foremost, the individual contacting the customer is not an alternative manner of processing claims; it is the sole method of processing claims. The fact that the claims do not state that an individual cannot contact or does not contact a customer or an insured is not pertinent to the failure of Foremost to teach at least the recited limitations.

There is further no teaching in Foremost of the recited "automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing." In Foremost, no services are automatically provided to the customer, let alone services provided, as recited in claim 3, in accordance with analyzing performed by a claim data analyzing component of a computer system. Rather, as noted above, Foremost teaches contact by an individual after the claim information is received.

Furthermore, there is no teaching in Foremost of enabling "claimants to self-service the claims for the sustained losses using the aggregated services" as recited in claim 3. Far from

enabling claimants to self-service claims, Foremost teaches having an individual contact the insured the very next business day. Furthermore, Foremost makes no reference to aggregated services whatever.

Contrary to the Examiner's Assertion, Borghesi Fails to Teach the "Claim Data Analyzing Component." Recited in Claim 3

Notwithstanding that the above-noted deficiency of the cited art is sufficient to require reconsideration and removal of all outstanding rejections under Section 103(a), Applicant further notes that Claim 3 also recites, *inter alia*,

> a site generating component generating a site on a global computer network allowing claimants to directly input information for insurance claims for sustained losses;
>
> a claim data analyzing component analyzing the inputted information and identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing;

The Examiner's assertion that Borghesi teaches "a claim data analyzing component analyzing the inputted insurance claim information" (i.e., information directly input by claimants on the site) and" identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing" is clear error. The Office Action of 12/3/2008 asserts, in Paragraph (2) of the Response to Arguments section, that this limitation may be found in Borghesi at col. 9, lines 43-56 and col. 17, lines 61-63. The Examiner further asserts in this paragraph that Borghesi's disclosure of "when the body shop verifies insurance coverage this is done via computer as is commonly known and inherent in the insurance industry and when the body shop determines whether to repair or tear down the car they are analyzing the claim data and making a decision to repair or tear down the car based on the claim data." Borghesi fails to teach a claim data analyzing component analyzing insurance claim information directly input by claimants on a site and identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing. As to the particular portions of Borghesi cited by the Examiner, first, at col. 9, lines 43-56, Borghesi merely teaches a party information frame, illustrated at Fig. 6, into which various categories of information are enterable by the user. There is no disclosure of a component that analyzes the inputted insurance claim information, verifies insurance coverage or summarizes the claims. Second, Borghesi at col. 17, lines 61-63, states that a body shop verifies

coverage at block 455 of Fig. 19. There is no indication that this step is performed by a computer system. Indeed, it is clear that the steps of Fig. 19 are not all performed by a computer system; for example, block 450 recites that the insured calls the insurance company and tows the car to the lot or impound yard (see Fig. 19). The Examiner's statement that the verification of insurance coverage is done via computer is "commonly known and inherent in the insurance industry" is unsupported by citation to a reference. The Examiner's statement that "when the body shop determines whether to repair or tear down the car they are analyzing the claim data" is not correct. The body shop does not determine whether to repair or tear down the car. In Borghesi, the determination is made by the appraiser/adjuster whether to deem the car a Total Loss (see col. 17, line 66 to col. 18, line 4). Indeed, in the field of automotive insurance, the determination of whether a car is deemed a total loss is conventionally made by an insurance company representative, such as an appraiser or adjuster, not the body shop. Moreover, the Examiner nowhere points to a component of Borghesi meeting the limitation: "summarizing the claims based on the analyzing." Accordingly, Borghesi fails to teach the above features.

Borghesi Fails to Teach Components That "Enable Claimants to Self-Service the Claims" As Recited in Claim 3

Independent Claim 3 recites, *inter alia*, "wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services." Such a system is disclosed throughout the subject application. The recitation of "enable claimants to self-service the claims for the sustained losses using the aggregated services" is a recitation of a system which permits consumers to process their own claims and utilize the ancillary services and commodities offered, without an agent, broker or an insurance company. The Examiner's comment in Paragraph (3) of the Response to Arguments section of the Office Action of 12/3/2008 that the feature "open-system" that permits the claims process to proceed without an agent, broker or an insurance company is not in the claims, completely fails the address the recitation of "enable claimants to self-service the claims for the sustained losses using the aggregated services." Accordingly, the Examiner has failed to identify this feature in the prior art.

As previously noted, such as in the response filed 10/31/2008, Borghesi presents a system that is not for use by claimants. Rather, the Borghesi system is "for use by insurance

companies as well as appraisers, repair shops, salvage yards and other support industries." *Col. 2, ll. 33-41.* Accordingly, Borghesi presents exactly that type of prior art system having the shortcomings and deficiencies that the present invention addresses by enabling insurance claimants to self-service insurance claims.

In an effort to remedy this admitted shortcoming, the Office Action seeks to modify the Borghesi system to enable clients to self-service insurance claims. However, such a modification of Borghesi would eliminate the problem that Borghesi itself seeks to address, namely, that an insurance claim adjuster must spend time keeping track of, and running, separate programs that may overlap and lead to redundant data entry tasks for insurance claim work flow (*see, col. 2, ll. 3-9).* Accordingly, the need for the Borghesi system is entirely eradicated.

One of ordinary skill in the pertinent art at the time of the invention would not have turned to Foremost to seek to modify the Borghesi system, where the problem solved by the Borghesi system (agents processing claims) is not present in the first place. Accordingly, proper grounds to modify the teachings of Borghesi to change its principle of operation are lacking.

For at least the foregoing reasons, the rejection of claim 3 should be withdrawn.

The Rejections of Claims 5-10 and 14 Should Be Withdrawn in View of Their Dependence from an Allowable Base Claim

Claims 5-10 and 14 depend from allowable base claim 3; the rejections of these claims should be withdrawn at least in view of their dependence from an allowable base claim.

The Borghesi Reference Fails to Teach the Online Consumer-to-Business Exchange Recited in Claim 15

Claim 15 depends from allowable base claim 3, and the rejection of claim 15 should be withdrawn at least in view of its dependence from an allowable base claim. The rejection of claim 15 should be withdrawn for at least the further grounds that the art of record fails to teach the recited limitation: "wherein the site is operative as an online consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss." In Paragraph (4) of the Response to Arguments Section of the Office Action of 12/3/08, The Examiner cites Borghesi as advertising a vehicle inspection, at col. 5, lines 6-15, and a salvage disposition at col. 6, lines 16-25. The

Examiner further states that these vendors are advertising their services to the insurance claimants because vehicle inspections and salvage dispositions are services that insurance claimants frequently need and therefore Borghesi does include an online consumer-to-business exchange. In fact, both the vehicle inspection and the salvage disposition are performed on behalf of the insurer in Borghesi. Borghesi states, at col. 5, lines 1-5:

> According to a presently preferred embodiment, a work assignment 10 is received by a claims adjuster after an accident has been reported. A vehicle inspection 12 is then conducted to determine the extent of damage to the insured vehicle.

In Borghesi, the claims adjuster performs the vehicle inspection. It is well understood in the field of automotive insurance claims that the insurance company, not the insured, employs a claims adjuster.

As to salvage dispositions, Borghesi states, at col. 5, lines 6-25:

> After the vehicle inspection has been recorded, at least two calculations may be made with regard to the vehicle. First, information from the vehicle inspection is used to determine a vehicle valuation 14 which values the vehicle based on several factors including age of the vehicle and prior damage. A damage estimate 16 is also made of the vehicle to attempt to define the repairs necessary to bring the vehicle back to its previous state. If the repair estimate approaches the vehicle valuation, the adjuster may decide to total out the vehicle.
>
> The next step is then to determine salvage disposition 18. Salvage disposition refers to bids made by local salvage parts lots for purchasing the remainder of the vehicle should it be totaled out by the adjuster. The numbers from the damage estimate and from the vehicle valuation, including salvage disposition, are then used by an adjuster who looks at these numbers to determine what type of settlement and/or adjustment 20 should be made. The final step of the claim processing chain is to pay out 22 to the insured the repair costs or the total loss amount.

From the above, it is clear that the adjuster, employed by the insurance company, decides whether to total out the vehicle. If the vehicle is totaled out, the insured receives the total loss amount. As is well understood in the field of vehicle insurance, the insured conveys title to the vehicle to the insurance company at this time. The insurance company, not the insured, obtains salvage disposition, as is evident from the above discussion, as well as from common practice in the field of vehicle insurance.

The Office Action also points to Borghesi, col. 5, lines 5-50 as teaching this limitation. However, this portion of Borghesi begins by describing steps associated with an automobile claim processing workflow (see col. 4, line 64 to col. 5, line 5). Claim processing is of course performed by an insurance company. The workflow includes a work assignment to an adjuster, performance of a vehicle inspection by an adjuster (col. 5, lines 6-15) and determining, by an adjuster, salvage disposition, at lines 16-25. The text then states that all of the information relating to a given claim may be contained in an electronic datafile, at lines 28-30. The text then notes that a workfile may contain total loss calculations, settlement information, an event log, notes, reports, form letters and rate tables, at lines 36-50. There is no reference to a consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss. The workflow merely describes, at a high level, the steps taken by an adjuster in response to a work assignment provided by an insurance company, and does not refer at all to providing products to rehabilitate a loss. The references to the datafile merely describe types of data and documents, and again have nothing to do with the recited online consumer-to-business exchange.

For at least these reasons, in addition to the reasons set forth above with reference to claim 3, the rejection of claim 15 should be withdrawn.

The Rejections of Claims 25, 27, 29-32, and 35-36 Are Respectfully Traversed

The rejection of claim 25 is respectfully traversed at least for the same reasons as the rejection of claim 3.

Claims 27 and 29-32 depend from allowable base claim 25; the rejection of these claims should be withdrawn at least by virtue of their dependence from an allowable base claim.

Claim 35 depends from allowable base claim 25; the rejection of claim 35 should be withdrawn at least by virtue of its dependence from an allowable base claim. Claim 35 is similar to claim 15, and the rejection of claim 35 should further be withdrawn for the same reasons that the rejection of claim 15 should be withdrawn.

Claim 36 depends from allowable base claim 25, and the rejection of claim 36 should be withdrawn at least by virtue of the dependence of claim 36 from an allowable base claim. In addition, contrary to the Office Action, there is no teaching in the cited portion of Borghesi of "suggesting multiple vendors and services for performing tasks and requirements associated with

rehabilitating a claim." As discussed above in connection with claim 15, the cited portion of Borghesi (col. 5, lines 5-50) merely relates to a claim workflow, for use by an adjuster engaged by an insurance company, and proposed information for a datafile. For at least the foregoing reasons, the rejection of claim 36 should be withdrawn.

The Rejection of Claim 16 Should Be Withdrawn as Based on Clear Error in Interpretation of Progressive.com and Failure to Address Applicant's Prior Traversal

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, and further in view of (3) Progressive.com (published on March 1, 2000). The rejection is respectfully traversed.

Claim 16 depends from claim 3, and further recites: "wherein the claim rehabilitation component suggests multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim." The Office Action alleges that page 1 of Progressive.com teaches multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim. There is simply nothing in the brief text on this page that relates to tasks and requirements associated with rehabilitating a claim, or with multiple vendors and services for performing those tasks. The references to claims amount to the wording "your personalized insurance service center for...individualized claim information and vehicle replacement quotes" and "Immediate Response Claims Service." There is simply nothing in this reference that teaches the limitations alleged by the Office Action to be taught. The Examiner's interpretation of Progressive.com is thus clear error. The Applicants noted this deficiency of Progressive.com in the Response filed 10/31/2008 (page 12). The Final Office Action of 12/3/2008 does not attempt to address this deficiency, either in the rejection or in the Response to Arguments, but merely repeats the same rejection. This rejection of claim 16 thus fails to meet MPEP 7.07(f) ("Where the applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it.")

For at least this reason, in addition to the dependence of claim 16 from allowable base claim 3, the rejection of claim 16 should be withdrawn.

The Rejection of Claim 17 Should Be Withdrawn as Based on Clear Error in Interpretation of King

Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King (United States Patent No. 5,704,045). The rejection is respectfully traversed on the grounds that King specifically states that its system is not exchange-based (col. 9, lines 9-12), in contrast to the recited business-to-business exchange of claim 17. Moreover, the system of King is not integrated with a system for insureds to self-service claims, and does not appear to disclose post-accident purchase and sale of risk obligations and subrogation rights.

The Final Office Action of 12/3/2008 asserts that King teaches an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights. The Examiner further argues in Paragraph (5) of the Response to Arguments section of the Final Office Action of 12/3/2008 that King states that its system does not impose the rigid contract limitations of an exchange-based structure and it does not imply that the system of King is not exchange based at all. The Examiner further states that King teaches post-accident purchase of sale of risk obligations and subrogation rights, at col. 14, lines 42-58.

King teaches a system of statutorily segregated reserve accounts through which compensation received for accepting risk is matched with equity or debt sourced from specific investors, being sufficient to pay a total loss on the maximum risk liability accepted (col. 3, lines 23-28). The system of reserve accounts is clearly not an exchange. Moreover, King states that the risk acceptance subsystem relies on the expertise of third party specialists using the data processing system to agree the acceptance of risk (col. 4, lines 10-13). There is clearly no exchange in King of wholesale claims or tranches of risk obligations. Rather, King requires individual agreements relying on the expertise of third party specialists. Thus, King clearly does not teach an exchange as recited in claim 17.

As to the Examiner's assertion that col. 14, lines 42-58 of King teaches post-accident purchase of sale of risk obligations and subrogation rights, that portion of King reads as follows:

> The present subsystem permits investors to provide funds to support risks through a method of individual investors acting as reinsurers, where the insurer-entity credits premium, loss reserves, investment income, etc. to the account of the

> investor. In some jurisdictions, investors, whether individual or corporate, may be able to book these transactions as reinsurance transactions, accepting premium income and expenses, less losses, having some tax related or accounting advantage. Liability may be limited to a deposit advanced by the investor or may be unlimited, however the insurer-entity maintains at all times the ability to fully meet the maximum obligation. Revenues generated after appropriate payments to these transactional capital participants again may remain within the Reserved Assets substructure for the benefit of primary shareholders or be transferred to the General Assets substructure for further use or distribution to primary shareholders.

This section of King does not mention post-accident purchase of risk obligations or subrogation rights at all. In contrast, this section indicates that investors may act as reinsurers, i.e., taking certain risks pursuant to a contract of reinsurance. For clarity, reinsurance is of course not the same as post-accident purchase of sale of risk obligations.

For at least these reasons, in addition to the dependence of claim 17 from allowable base claim 3, the rejection of clam 17 should be withdrawn.

The Rejections of Claims 18-19 Should Be Withdrawn as Based on Clear Error in Interpretation of Ryan

Claims 18 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King, further in view of (4) Ryan (United States Patent No. 5,655,085). The rejection is respectfully traversed on the grounds that Ryan relates to evaluating life insurance policies prior to purchase (Abstract, lines 1-3), and has nothing to do either with scoring claims of any type, or with property and casualty insurance. As to claim 19, Ryan has no disclosure of accident description, loss state, responsible party or subrogation value.

In Paragraph (6) of the Response to Arguments section of the Office Action of 12/3/2008, the Examiner maintains that Ryan teaches, in col. 1, lines 38-51, scoring claims, accident description, loss state, responsible party and subrogation value.

Ryan, at col. 1, lines 38-51, reads as follows:

> Using such single-computer based systems, insurance sellers of annuities, health policies, and term life insurance could request quotes from a large data base of insurance carriers' products. The computer computes the price of a particular financial product offered by a particular carrier for a given customer of a given age, sex, and health, or insured population profile. Then the computer repeats this operation for a large number of different insurance companies. Comparing the

> values so calculated for a larger number of different carriers' insurance products has permitted the computer to automatically identify that product which provides the best value for the consumer. This also permitted the seller to provide the insurance purchaser with the least expensive quote with a minimum of effort.

The above-quoted excerpt relates to obtaining quotes for premium amounts for life insurance policies. The excerpt of Ryan has nothing to do with scoring claims, accident description, loss state, responsible party and subrogation value, the Examiner's assertion to the contrary notwithstanding.

The Examiner further asserts that since Ryan and the present application relate to the field of insurance, the Ryan reference is in an analogous field to the instant application. Applicants respectfully note that Ryan, while in the broad field of insurance, relates to a different category of insurance, namely life insurance. Furthermore, the present application relates to claims, while Ryan relates to evaluating policies prior to purchase. No reason has been provided why one of ordinary skill would look to the teachings of Ryan in connection with scoring submitted claims.

For at least these reasons, in addition to the dependence of claims 18 and 19 from allowable base claims 3 and 17, the rejection of claims 18 and 19 should be withdrawn.

The Rejection of Claims 20 and 21 Should Be Withdrawn as Based on Clear Error in Interpretation of Ertel

Claims 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King, further in view of (4) Ryan, further in view of (5) Ertel (United States Patent No. 5,307,262).

The rejection is respectfully traversed on the grounds that Ertel has no disclosure whatever related to bundling claims for subrogation value, and further utterly lacks a sale price determining component. Ertel has to do with identifying and correcting problems in data quality (col. 5, lines 21-25). Ertel does not relate to classifying claims to be bundled in groups for subrogation. The Office Action points to column 29, lines 11-48, which relates to archiving of records and organization of archived data. This portion of Ertel has nothing to do with subrogation.

In Paragraph (7) of the Response to Arguments section of the Office Action of 12/3/2008, the Examiner states that Ertel, at col. 5, lines 20-39, teaches at least classifying

claims to be bundled in groups for subrogation. The Examiner may also be asserting that col. 5, lines 20-39 teaches a sale price determining component. The cited portion of Ertel reads as follows:

> An object of the present invention is to provide a method and system that utilize the efficiency of batch operations to analyze claims data on entire groups of patients for the purpose of identifying and correcting both case-specific and systematic problems in data quality in the most efficient way possible. Detected problems, which include both actual errors and potential or suspected misreporting, are classified as to potential consequences. The ability to classify messages makes it possible to prioritize individual cases for in-depth review based upon user-defined criteria of importance. Classification of reporting problems with regard to their source makes it possible to automatically route relevant data quality messages to the appropriate recipient personnel. Finally, aggregate data profiles are generated that categorize data quality problems by both type and source, making it possible to identify systematic problems in data quality, intervene appropriately, and monitor subsequent progress over time.

The above excerpt clearly has nothing to do with subrogation. Moreover, the above excerpt refers to classification of messages and reporting problems, not to classification of claims. There is clearly no sale price determining component in Ertel.

For at least these reasons, in addition to the ultimate dependence of claims 20 and 21 from allowable base claims 3 and 17-19, the rejection of claims 20 and 21 should be withdrawn.

The Rejection of Claim 23 Should Be Withdrawn as Based on Clear Error in Interpretation of Burks

Claims 22-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) Burks (United States Patent No. 6,453,297).

The rejection of claim 22 should be withdrawn at least by virtue of the dependence of claim 22 from allowable base claim 3.

The rejection of claim 23 is respectfully traversed, on the grounds that there is no teaching in the cited art of concealing the identities of claimants who have input claims for sustained losses when searching for similar claims. The Office Action cites col. 16, lines 34-46 of Burks as teaching concealing identities of claimants. However, the cited portion of

Burks relates to a statistical analyzer, and does not provide any indication of concealing identities of claimants. For this reason alone, the rejection of claim 23 fails to provide a proper prima facie case of obviousness. Furthermore, Burks relates to medical claims, where patient confidentiality is of concern. Indeed, there is a regulatory system, generally known by the acronym HIPAA, directed to protection of patient confidentiality. However, the system of claim 3 relates to claims for sustained losses, not to medical insurance claims. Thus, motivations for concealing claimant identities applicable to medical insurance claims are not pertinent to sustained losses.

The Office Action recites that the motivation for concealing the identities of users is for "providing a user with a means of containing insurance costs." However, concealing the identities of users does not advance the goal of containing insurance costs. The Office Action relies on col. 16, lines 42-25 of Burks for support for the motivation of containing insurance costs. However, the cited portion of Burks states that statistical analyzer is beneficial in containing healthcare costs, and does not suggest that concealing identities is beneficial in containing costs. Accordingly, the Examiner has not provided an applicable teaching, suggestion or motivation, or line of reasoning, for providing for concealing identities of claimants when searching in the database of claims for sustained losses.

The Examiner's comments in Paragraph (8) of the Response to Arguments of the Office Action of 12/3/2008 are not on point. The Examiner states that it is inherent that an insured's identity would also be concealed in the system of Burks because there would be no reason to have the identity of the insured in Burks when the purpose of analyzing the records in Burks is for statistical analysis and this type of analysis does not require that the identity of any particular insured or claimant be revealed. However, Burks provides no indication of an identity concealing component. The Examiner's statement that statistical analysis does not require that the identity of any particular insured or claimant be revealed appears to be mere speculation. Indeed, statistical analysis might involve determining which procedures are commonly performed on the same person, thereby rendering valuable the availability of patient identities for purposes of statistical analysis.

The Response to Arguments further states that Burks teaches performing statistical analysis for subgroups and this analysis is also anonymous because it is inherent that all of the insured's identities would also be concealed in the system of Burks when the purpose of

analyzing the records is for statistical analysis and this type of analysis does not require that the identity of any particular insured or claimant be revealed. Again, in principle, the identities of claimants may be useful in performing statistical analysis, and there is no indication in Burks of a claimant identity concealing component as recited in claim 23.

For at least the foregoing reason, in addition to the dependence of claim 23 from allowable base claim 3, the rejection of claim 23 should be withdrawn.

The Rejection of Claim 24 Should Be Withdrawn as Based on Clear Error in Interpretation of Ertel

Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) Burks, and even further in view of (4) Ertel.

The rejection is respectfully traversed. Ertel, like Burks, also relates to medical claim information, and not to claims for sustained losses. The Office Action does not call out any portion of Ertel that allegedly teaches "pooling common issues into anonymous class groups" in connection with claims for sustained losses. There is no teaching, suggestion or motivation in the art, and no line of reasoning furnished by the Office Action, for providing "pooling common issues into anonymous class groups" in connection with claims for sustained losses.

For at least the foregoing reason, in addition to the dependence of claim 24 from allowable base claims 3 and 23, the rejection of claim 24 should be withdrawn.

Claims 37-44 are Similar to Claims 17-24 and the Rejections of Claims 37-44 Should be Withdrawn for the Same Reasons as the Rejections of Claims 17-24

Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King. The limitations of claim 37 are similar to the limitations of claim 17. For at least the reasons set forth above in connection with claim 17, in addition to the dependence of claim 37 from allowable base claim 25, the rejection of claim 37 should be withdrawn.

Claims 38 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King, further in view of (4) Ryan. The limitations of claims 38 and 39 are similar to the limitations of claims 18 and 19. For at least

the reasons set forth above in connection with claims 18 and 19, in addition to the dependence of claims 38 and 39 from allowable base claims 25 and 37, the rejections of claims 38 and 39 should be withdrawn.

Claims 40-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Borghesi in view of (2) Foremost, further in view of (3) King, still further in view of (4) Ryan, and yet further in view of (5) Ertel.

These rejections are respectfully traversed. Claim 40 is similar to claim 20; the rejection of claim 40 should be withdrawn for at least the reasons set forth above in connection with claim 20, in addition to the dependence of claim 40 from allowable base claims 25 and 37-39.

Claim 41 is similar to claim 21; the rejection of claim 41 should be withdrawn for at least the reasons set forth above in connection with claim 21, in addition to the dependence of claim 41 from allowable base claims 25 and 37-40.

Claim 42 is similar to claim 22; the rejection of claim 42 should be withdrawn for at least the reasons set forth above in connection with claim 22, in addition to the dependence of claim 42 from allowable base claims 25 and 37-41.

Claim 43 is similar to claim 23; the rejection of claim 43 should be withdrawn for at least the reasons set forth above in connection with claim 23, in addition to the dependence of claim 43 from allowable base claims 25 and 37-42.

Claim 44 is similar to claim 24; the rejection of claim 44 should be withdrawn for at least the reasons set forth above in connection with claim 24, in addition to the dependence of claim 44 from allowable base claims 25 and 37-43.

CONCLUSION

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

Dated: February 3, 2009

Robert E. Rosenthal
Reg. No. 33,450
Howard IP Law Group, P.C.
P.O. Box 226
Fort Washington, PA 19034
Tel: (215) 542-5824
Fax: (215) 542-5825